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Rajko Milovanovic

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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT

PAPER NUMBER

2421

NOTIFICATION DATE

DELIVERY MODE

02/03/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@ti.com

Office Action Summary	Application No. 09/923,232	Applicant(s) MILOVANOVIC ET AL.	
	Examiner Hoang-Vu A. Nguyen-Ba	Art Unit 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 10, 12, 29, 34, 46, 49, 52 and 55-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10, 12, 29, 34, 46, 49, 52 and 55-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2421

DETAILED ACTION

1. In view of the Appeal Brief filed on October 21, 2008, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/John W. Miller/

Supervisory Patent Examiner, Art Unit 2421

2. Claims 1, 10, 12, 29, 34, 46, 49, 52 and 55-58 are pending. Claims 1, 10, 12, 29, 34, 46, 49 and 52 are independent claims.

Response to Arguments

3. Applicants' arguments in the Appeal Brief have been fully considered and are persuasive. The final rejection of claims 1, 10, 12, 29, 34, 46, 49, 52 and 55-58 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Merjanian and Darbee et al is withdrawn and a new ground of rejection is introduced herein.

Claim Rejections – 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejection under this section made in this Office action:

Art Unit: 2421

A person shall be entitled to a patent unless –

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 10, 12, 29, 34, 46, 49 and 52 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,850,632 to Boyd et al. (“Boyd”).

It should be noted that hereinafter the use of the clause “see at least” should be interpreted that the cited portions that follow the clause are not the only portions that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the same reference, the introduction of the additional evidence in response to Applicant’s arguments should not therefore be considered to be that of new grounds of rejection.

Claim 1

Boyd discloses *a system for user recognition and customized content provisioning* (see at least FIGs. 1-2, 5), *the system comprising:*

a remote control device having a plurality of control keys, the remote control device including a fingerprint sensor embedded in one of said control keys, whereby activation of said one of said control keys reads fingerprint data of a user’s finger, said control keys including at least some control keys disposed in a thumb actuated cross configuration , and wherein said fingerprint sensor is integrated within the middle portion of the thumb operated cross configuration (see at least FIGs. 1-2, button 14); and

an apparatus (see at least FIG. 5 and 4:45-5:28) *capable of presenting customized content to the user controllable by activation of said plurality of control keys, the customized content selected dependent upon said fingerprint data of the user’s finger* (see at least 3:23-4:44).

Claim 10

Boyd discloses *an apparatus for content provisioning* (see at least FIGs. 1-2, 5) *comprising:*

means for acquiring data related to a user without active user input or participation, the means for acquiring data including a remote control device having a plurality of control keys and a fingerprint sensor embedded in one of the control keys, whereby activation of said one of one of said control keys reads fingerprint data of user's finger, said control keys including at least some control keys disposed in a thumb actuated cross configuration, and said fingerprint sensor is integrated within the middle portion of the thumb operated cross configuration (see at least FIGs. 1-2, button 14); and

means for presenting customized content to the user controllable by activation of said plurality of control keys, said customized content selected in response to said fingerprint data of the user's finger (see at least 3:23-4:44).

Claim 12

Boyd discloses *a television system* (see at least FIG. 5; it is noted that the display 52 is a television receiver – 4:51) *comprising:*

a remote control device having a plurality of control keys, the remote control device including a fingerprint sensor embedded in one of said control keys, whereby activation of said one of said control keys reads fingerprint data of a user's finger, said control keys including at least some control keys disposed in a thumb actuated cross configuration, and said fingerprint sensor is integrated within a middle portion of the thumb operated cross configuration (see at least FIGs. 1-2, button 14 embedding a fingerprint sensor);

a processor (see at least FIG. 5, device 44) *communicatively coupled* (see at least 2:23-31) *to the remote control device* (see at least FIG. 5, device 10), *the determining*

Art Unit: 2421

characteristics of the user based upon the fingerprint data (see at least 11:17 – 12:14);
and

a display (see at least FIG. 5, device 52) providing content to be viewed by the user, the content being customized for the user based upon the characteristics determined by the processor (see at least 2:23-31).

Claim 29

Boyd discloses *a remote control device (see at least FIGs. 1-2, device 10) comprising:*

a housing (see at least FIGs. 1-2, device 12);

electronic circuitry disposed within the housing (see at least FIG. 2, circuit 26);

a signal transmitter disposed within the housing (see at least FIG. 5, device 26; 2:22-31; it is noted that in order to wirelessly convey information about the image captured by the sensor to the processor-based system 42, the device 26 must necessarily comprise a transmitter-receiver without which the information transmitting and receiving would be inoperative);

a plurality of control keys disposed on an outer surface of the housing, at least some of the control keys operable by hand (see at least FIGs. 1-2).

Claim 34

Boyd discloses *a device (see at least FIGs. 1-2, device 10) comprising:*

a housing (see at least FIGs. 1-2, device 12);

electronic circuitry disposed within the housing (see at least FIG. 2, circuit 26);

a signal transmitter disposed within the housing (see at least FIG. 5, device 26; 2:22-31; it is noted that in order to wirelessly convey information about the image captured by the sensor to the processor-based system 42, the device 26 must necessarily

Art Unit: 2421

comprise a transmitter-receiver without which the information transmitting and receiving would be inoperative);

a plurality of control keys disposed on an outer surface of the housing, at least some of the control keys operable by hand (see at least FIGs. 1-2, the control keys shown on the surface of device 12), the control keys including an activation key operable to activate a remote control device (see at least FIGs. 1-2, key 14; it should be noted that without a user positioning over the select button 14, the remote controller 10 is inactive or in a sleep mode - no signal is sent from or received by the remote controller 10 – but as soon as a user's finger is positioned over button 14, an image of the user's fingerprint is captured and authenticated by the sensor; if the user is an authorized user, the remote controller is waking up and switching to an active state which consists of awaiting a pressing of key 14 to send a signal to the controlled device, such as a TV; therefore, the claimed control keys including an activation key -- i.e., key 14 -- operable to activate a remote control device is considered met by key 14); and

a fingerprint sensor integrated within the activation key (see at least FIG. 2, components 14, 20, 22, 24, 25, 26).

Claim 46

Boyd discloses *a system for user recognition and customized content provisioning (see at least FIGs. 1-2, 5), the system comprising:*

a remote control device having a plurality of control keys (see at least FIGs. 1-2, device 10), the remote device including a fingerprint sensor embedded in one of said control keys, whereby activation of said one of said control keys reads fingerprint data of user's finger (see at least FIGs. 1-2, key 14),

said control keys include an activation key operable to activate the remote control device (see at least FIGs. 1-2, key 14; it should be noted that without a user positioning over the select button 14, the remote controller 10 is inactive or in a sleep mode - no signal is sent from or received by the remote controller 10 – but as soon as a user's finger

Art Unit: 2421

is positioned over button 14, an image of the user's fingerprint is captured and authenticated by the sensor; if the user is an authorized user, the remote controller is waking up and switching to an active state which consists of awaiting a pressing of key 14 to send a signal to the controlled device, such as a TV; therefore, the claimed *control keys including an activation key -- i.e., key 14 -- operable to activate a remote control device* is considered met by key 14), *and said fingerprint sensor is embedded in the activation key* (see at least FIGs. 1-2, key 14); *and*

an apparatus capable of presenting customized content to the user controllable by activation of said plurality of control keys, the customized content selected dependent upon said fingerprint data of the user's finger (see at least 3:23-4:44).

Claim 49

Boyd discloses *an apparatus for content provisioning* (see at least FIGs. 1-2, 5) *comprising:*

means for acquiring data related to a user without active user input or participation (see at least FIGs. 1-2, key 14), *the means for acquiring data including a remote control device having a plurality of control keys* (see at least FIGs. 1-2, device 10) *and a fingerprint sensor embedded in one of the control keys, whereby activation of said one of said control keys reads fingerprint data of a user's finger* (see at least FIGs. 1-2, key 14), *said control keys include an activation key operable to activate the remote control device* (see at least FIGs. 1-2, key 14; it should be noted that without a user positioning over the select button 14, the remote controller 10 is inactive or in a sleep mode - no signal is sent from or received by the remote controller 10 - but as soon as a user's finger is positioned over button 14, an image of the user's fingerprint is captured and authenticated by the sensor; if the user is an authorized user, the remote controller is waking up and switching to an active state which consists of awaiting a pressing of key 14 to send a signal to the controlled device, such as a TV; therefore, the claimed *control keys including an activation key -- i.e., key 14 -- operable to activate a remote control device*

Art Unit: 2421

is considered met by key 14), and said fingerprint sensor is embedded in the activation key (see at least FIGs. 1-2, key 14); and

means for presenting customized content to the user controllable by activation of said plurality of control keys, said customized content selected in response to said fingerprint data of the user's finger (see at least 3:23-4:44).

Claim 52

Boyd discloses *a television system (see at least FIG. 5; Abstract, lines 8-10) comprising:*

a remote control device having a plurality of control keys, the remote control device including a fingerprint sensor embedded in one of said control keys, whereby activation of said one of said control keys reads fingerprint data of a user's finger (see at least FIGs. 1-2, key 14), said control keys include an activation key operable to activate the remote control device (see at least FIGs. 1-2, key 14; it should be noted that without a user positioning over the select button 14, the remote controller 10 is inactive or in a sleep mode - no signal is sent from or received by the remote controller 10 – but as soon as a user's finger is positioned over button 14, an image of the user's fingerprint is captured and authenticated by the sensor; if the user is an authorized user, the remote controller is waking up and switching to an active state which consists of awaiting a pressing of key 14 to send a signal to the controlled device, such as a TV; therefore, the claimed control keys including an activation key -- i.e., key 14 -- operable to activate a remote control device is considered met by key 14), and said fingerprint sensor is embedded in the activation key (see at least FIGs. 1-2, key 14);

a processor (see at least FIG. 5, device 44) communicatively coupled (see at least 2:23-31) to the remote control device (see at least FIG. 5, device 10), the determining characteristics of the user based upon the fingerprint data (see at least 2:23-31); and

a display (see at least FIG. 5, device 52) providing content to be viewed by the user, the content being customized for the user based upon the characteristics determined by the processor (see at least 2:23-31).

Claim Rejections – 35 USC § 103

6. The following is a quotation of the 35 U.S.C. § 103(a) which form the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 55-58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,850,632 to Boyd et al. (“Boyd”) in view of U.S. Patent No. 5,883,680 to Nykerk.

It should be noted that hereinafter the use of the clause “see at least” should be interpreted that the cited portions that follow the clause are not the only portions that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the same reference, the introduction of the additional evidence in response to Applicant’s arguments should not therefore be considered to be that of new grounds of rejection.

Claim 55

The rejection of base claim 34 is incorporated. Boyd does not specifically disclose the features recited in the claim.

However, in an analogous art, Nykerk discloses *wherein*:

said electronic circuitry is operable to enter a sleep mode if none of said plurality of control keys is operated for a predetermined period of time (see at least 6:53-6:9), and re-activate from said sleep mode upon operation of said activation key and re-acquiring fingerprint data via said fingerprint sensor(see at least 6:53-6:9).

Boyd-Nykerk further discloses *and forget fingerprint sensor data* (Boyd; 2:66-3:2; since Boyd device does not specifically disclose a memory to retain the captured fingerprint, it has to periodically image or sense the fingerprint).

Claim 56

The rejection of base claim 46 is incorporated. Since Claim 56 recites a system comprising the same features of the device claimed in Claim 55, the same rejections are applied.

Claim 57

The rejection of base claim 49 is incorporated. Since Claim 57 recites an apparatus with the same features of the device claimed in Claim 55, the same rejections are thus applied.

Claim 58

The rejection of base claim 52 is incorporated. Since Claim 58 recites a television system with the same features of the device recited in Claim 55, the same rejections are thus applied.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hoang-Vu A. Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Monday -Friday from 9:00 – 17:30.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2400 Group receptionist: 571-272-2400.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hoang-Vu Antony Nguyen-Ba/

Application/Control Number: 09/923,232

Page 11

Art Unit: 2421

Primary Examiner, Art Unit 2421
January 27, 2009